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TECHNOLOGY CENTER R3700

Attorney Docket No.: FC01402

Serial No.: 09/981,197

Filing Date: October 16, 2001

Inventor: John W. Davis et al.

PTO/SB92 (08-00)

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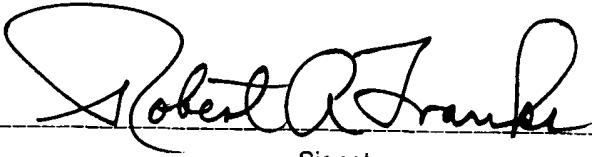
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Robert A. Franks

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Documents enclosed:

Response (3 pages)

Formal drawings (12 sheets) - in duplicate

Copies of: US 4,674,204; US 4,910,886; and US 2002/0007569 A1

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TECHNOLOGY CENTER R3700

CASE NO. FC01402

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John W. Davis et al.

Application No. 09/981,197

Art Unit: 3728

Filed: October 16, 2001

Examiner: J. Kavanaugh

For: INSERT MOLDING APPARATUS AND METHOD

Commissioner for Patents  
Washington, D.C. 20231

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Sir:

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RESPONSE

In response to the Office Action mailed on January 16, 2003 for the subject application, applicants respectfully request consideration of the following remarks.

The Office Action imposed a requirement for restriction of the pending claims, considered to include three "inventions" grouped as follows:

Group I: claims 1-7 directed to apparatus for molding;

Group II: claims 8-13 directed to a method for molding; and

Group III: claims 14-16 directed to an insole.

Applicants submit that this restriction requirement is improper, as it does not comply with guidelines promulgated by the Office in M.P.E.P. § 802.01, which states that inventions are distinct if they "are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER..." The Office Action provides no evidence that the matter of separate patentability was given consideration; only factors regarding the separate manufacture and use issues are discussed.

Moreover, the M.P.E.P. (in § 803) provides guidance concerning the criteria for restriction: (A) the inventions must be independent or distinct; and (B) there must be a serious burden on the examiner. It is stated that: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Indeed, it is not apparent to applicants just how the claims of Group II, directed to the method for molding, could possibly be examined without consulting the relevant apparatus art, since those method claims recite features of the particular apparatus which is required to be employed. Thus, only a single search should be required if all of claims 1-13 are simultaneously examined.

The fact that different claims would have different classifications does not dispose of the examination burden issue, since it is very common for a patent to have a number of classes and subclasses listed on its front. If all of the relevant art is readily available to the examiner, then differing classifications do not justify a restriction.

In view of the foregoing, applicants are willing to acquiesce to the restriction of the Group III claims, but respectfully urge reconsideration of the separation of Groups I and II. However, if the entire requirement is maintained, examination should proceed with the apparatus claims of Group I.

Enclosed is a new set of drawings, comprising twelve sheets and being submitted in duplicate. The originally filed drawings have been altered to conform to the formal requirements of the Office, and this new set should facilitate examination of the application.

Also enclosed are copies of the two U.S. patent documents (4,674,204 and 4,910,886) that are mentioned on page 1 of the application, and a copy of U.S. Patent Application Publication 2002/0007569 A1 which corresponds to the pending application mentioned on page 7 of the present application. These documents may facilitate a better understanding of the invention.

As all of the pending claims are believed to be patentable, examination of the entire claim set and an early notification of their allowance are respectfully solicited. However, if any minor matters remain to be resolved before disposition of the application, kindly contact the undersigned to arrange for a telephonic or personal interview.

Respectfully submitted,



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